

**Response Under 37 CFR § 1.116**

**Expedited Procedure**

**Examining Group No. 2613**

Application No. 09/937,460

Paper Dated: September 14, 2005

In Reply to USPTO Correspondence of January 14, 2005

Attorney Docket No. 3135-011614

**REMARKS**

This Amendment further amends independent claims 22 and 36. Support for the amendments may be found, for example, on page 7, lines 13-17 of the application.

Claims 22, 27, 32 and 36 stand rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent No. 4,175,860 to Bacus (“Bacus ‘860”). Claims 23, 30, and 37 stand rejected under 35 U.S.C. § 103(a) for obviousness over Bacus ‘860 in view of U.S. Patent No. 6,297,825 to Madden et al. (“Madden”). Claims 24-26, 28, 29, 31, 33-35, and 38-42 stand rejected under 35 U.S.C. § 103(a) for obviousness over Bacus ‘860 in view of U.S. Patent No. 5,134,662 to Bacus et al. (“Bacus ‘662”). Applicant respectfully traverses these rejections for the following reasons.

As amended, independent claim 22 is directed to a device for selecting and recording an image of an irradiated or emissive structure of DNA, RNA or protein. The device includes an object holder for positioning the structure, a mirror for reflecting an image of the structure, and a displaceable camera for selecting a part of the image from the reflected image of the object.

Amended independent claim 36 is directed to a method for selecting an image to be recorded with a camera which forms a part of an irradiated or emissive object comprising DNA, RNA or protein structures. The method includes placing the DNA, RNA or protein structure in a stationary position, reflecting an image of the structure with a mirror, and selecting with a displaceable camera a part of the image of the structure to be viewed from the reflected image.

Bacus '860 discloses an apparatus for performing automated classification of cells. Referring to Fig. 1 of this patent, the apparatus includes a lens (12), a beam splitter (20), and a camera (24). The Examiner did not give patentable weight to the Applicant's last claim amendment, because the amended terms were located in the preamble.

The present invention, as set forth in amended independent claim 22, pertains now more specifically to an improvement in a device for selecting and recording an image of a structure of DNA, RNA or protein. The device includes an object holder for positioning the structure, a mirror for reflecting the image, and a displaceable camera for selecting at least part

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of the image. The method of amended claim 36 includes placing the structure in a stationary position, such as on the object holder, reflecting the image, and selecting at least part of the image with the displaceable camera.

In contrast, Bacus '860 and '662 relate to improvements in relation to classifying and analyzing cells using microscope techniques. Each of these references discloses that the cells may be red blood cells, cells of a pap smear, blood cell neutrophiles, and the like. Madden relates to an analyzing technique for visual scenes from a series of images. None of these references is any way analogous to the presently claimed invention as set forth in independent claims 22 and 36. Thus, the Examiner's rejections based on the cited references are improper because the cited references are non-analogous art.

Pursuant to MPEP § 2141.01(a), in determining whether a prior art reference is analogous, it should be determined (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. In determining whether the reference is reasonably pertinent to the problem the invention intends to solve, the purpose of both the invention and the prior art are important. Thus, if a reference disclosure has the same purpose as the claimed invention, an inventor may well have been motivated to consider the reference; on the other hand, if it is directed to a different purpose, the inventor would have less motivation to consider it.

Here, the field of technology of the Bacus patents is completely different from the present invention. The field of technology of the present invention relates to the selection and recording of biotechnical samples (i.e., DNA/RNA) of a completely different size and scale than the cellular analysis techniques and apparatus disclosed by the Bacus patents. Applicant respectfully submits that one skilled in the art would not look to the cellular analysis structure of the Bacus patents when seeking to solve the problem associated with selecting and recording images of DNA, RNA or proteins. The scale difference between the two fields of endeavor is entirely too great for the Bacus patents to be considered reasonably pertinent to the field of the Applicant's endeavor. Furthermore, Bacus '860 requires a beam splitter mirror (20) which is not required in the present invention now claimed.

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With the invention as now claimed, one may visualize not only structures of DNA, RNA and proteins, but also the *complexes* of DNA, RNA or proteins. The Examiner will note that claim 22 is now in Jepson form, so that the preamble of that claim must be given patentable weight. See 37 CFR § 1.75(e). Accordingly, there is no motivation in the Bacus patents to arrange a displaceable camera in association with a mirror for recording an image of an irradiated or emissive structure of DNA, RNA or protein, positioned in an object holder, as set forth in independent claim 22.

Method claim 36, now amended to further specify DNA, RNA or protein structures in the body of the claim, is also deemed allowable over the prior art of record for the same reasons set forth above.

For all the foregoing reasons, independent claims 22 and 36 distinguish over the cited references. For the same reasons, dependent claims 23-35 and 37-42 are also deemed allowable.

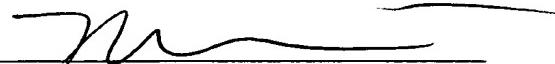
With respect to independent claims 22 and 36, Applicant acknowledges with thanks the withdrawal of the anticipation rejection of those claims over Bacus '860.

In conclusion, the Examiner's more recent obviousness rejection of independent claims 22 and 36 over the non-analogous Bacus '860 should be withdrawn, in light of the current amendments. Reconsideration of the Examiner's rejections and allowance of pending claims 22-42 are respectfully requested.

Respectfully submitted,

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